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| 10/560,301      | 05/30/2007  | Jun-Keun Chang       | LT00012 US          | 3208             |

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| EXAMINER |
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BEISNER, WILLIAM H

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1775

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

03/07/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LifetechDocket@system.foundationip.com  
paralegals@system.foundationip.com

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/560,301             | CHANG ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | WILLIAM H. BEISNER     | 1775                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) 29-42, 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/16/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Election/Restrictions**

1. Applicant's election without traverse of Group I, Claims 18-28 and 43-45, in the reply filed on 12/13/2010 is acknowledged.
2. Claims 29-42, 46 and 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/13/2010.

### **Priority**

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Information Disclosure Statement**

4. The information disclosure statement filed 1/16/2007 has been considered and made of record.

### **Drawings**

5. The drawings were received on 5/12/2006. These drawings are acceptable.
6. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37

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CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 18-28 and 43-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to independent claims 18 and 25, Claim element "pressure maintaining means" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

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(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

With respect to claims 21 and 25, “the electrode” lacks antecedent basis.

With respect to claim 25, the recited “an electrode terminal for electrically connecting the fixing unit” is indefinite because is it not clear how the fixing unit electrically participates in the generation of electric pulses.

With respect to claim 26, how does the “conductive contact” structurally cooperate with the previously recited "an electrode terminal", if at all?

With respect to claim 43, “the other electrode” and “the electrode insertion unit” lack antecedent basis. Note claim 18 is silent with respect to these elements.

Note claims 19, 20, 22-24, 27, 28, 44 and 45 are deemed indefinite in view of their dependency on indefinite claims.

### **Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 18-25, 27, 28 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Preece et al.(EP 0 338 667).

With respect to claim 18, the reference of Preece et al. discloses a device that is capable of electroporation (Figure 1) that includes a long hollow specimen-stuffing member (14) of non-conductive material; a reservoir (24,32) connected to a distal end of the specimen-stiffing member (14) for fluid communication; and a pressure maintaining means (28) connected to the other distal end of the specimen-stuffing member (14) for fluid communication.

With respect to claim 19, the specimen-stuffing member (14) has a ratio of length to cross-sectional area in the range of 50-10,000 (See column 3, lines 45-50).

With respect to claim 20, the hollow specimen-stuffing member (14) is a capillary tube.

With respect to claims 21 and 22, the pressure maintaining means (28) is connected by a connector (10) disposed with an electrode insertion unit (20) for inserting an electrode (18) which can electrically contact a specimen held in specimen-stuffing member (14).

With respect to claim 23, upper member (10) with lateral electrode insertion (20) of the reference of Preece et al. meets the structure recited in claim 23.

With respect to claim 24, the pressure maintaining means (28) is a syringe.

With respect to claim 25, the reference of Preece et al. discloses a device that is capable of electroporation (Figure 1) that includes a long hollow specimen-stuffing member (14) of non-conductive material; a reservoir (24,32) with an electrode (18) connected to a distal end of the specimen-stiffing member (14) for fluid communication; a pressure maintaining means (28) connected to the other distal end of the specimen-stuffing member (14) for fluid communication;

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and a reservoir holder (10) for holding or fixing the reservoir (24, 32) and the pressure maintaining means (28) and includes electrode terminals projecting from chambers (20).

With respect to claim 27, the hollow specimen-stuffing member (14) is a capillary tube.

With respect to claim 28, the specimen-stuffing member (14) has a ratio of length to cross-sectional area in the range of 50-10,000 (See column 3, lines 45-50).

With respect to claim 43, the device of Preece et al. also includes a pulse generator (36).

### **Allowable Subject Matter**

11. Claims 26, 44 and 45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

Claims 26, 44 and 45 would be allowable because the prior art of record fails to teach or fairly suggest the combination of elements recited in claims 26 and 45 that additionally include a pipette/piston device wherein the electrode is movable and connected with the pipette piston.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references of Toda et al.(JP 63-049070) and Ryttsen et al.(US 7,456,012) are cited as prior art that pertains to pressure maintaining devices that includes electrodes structures for generating electric fields to samples within the devices.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM H. BEISNER whose telephone number is (571)272-1269. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael A. Marcheschi, can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/William H. Beisner/  
Primary Examiner  
Art Unit 1775**

WHB